

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re: Application No. 09/425,436 )  
 ) *Confirmation No. 9564*  
Filed: October 22, 1999 )  
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Applicants: Richard Robert CAPPADONA ) This Reply Brief was electronically  
 et al. ) filed using the USPTO's EFS-Web.  
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Title: LID FOR COOKING PAN )  
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Art Unit: 1761 )  
 )  
Examiner: Drew E. BECKER )  
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 )  
Attorney Docket: 7015/66635 )  
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Customer No.: 22242 )

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Alexandria, Virginia 22313-1450

**APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41(a)(1)**

Sir:

This Reply Brief is filed in response to the Examiner's Answer dated April 20, 2006.

Application No. 09/425,436

APPELANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41(a)(1) dated June 20, 2006

Reply to Examiner's Answer of April 20, 2006

## **I. STATUS OF CLAIMS**

Claims 2-6 and 8-23 are pending. Claims 2-6 and 8-19 are allowed. Claims 20 to 23 are the pending claims that are at issue in this appeal and stand at least twice rejected. Claims 1 and 7 are cancelled. A claims appendix in the Appeal Brief presents the claims at issue in the appeal.

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## **II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Would claims 20-22 have been obvious to one of ordinary skill in the art at the time the invention was made over Barbour (U.S. Patent No. 6,293,271) in view of Bosch (DE 75 27 182)?

2. Was claim 23 obvious to one of ordinary skill in the art at the time the invention was made over Barbour in view of Bosch and Hupf et al. (U.S. Patent No. 6,004,000)?

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### III. ARGUMENT

#### A. The rejection based on Barbour and Bosch is not proper because it relies on creativity and hindsight to suggest the invention

Claim 20 recites a waterless cooking pan that includes a number of features, among them "said thermometer . . . being removable from said knob body by lifting the thermometer therefrom to facilitate cleaning." In arguing that the combination of Barbour and Bosch suggests the invention, the Examiner's Answer is imparting creativity and applying hindsight to one of ordinary skill in the art.

Creativity is not allowed in combining references. The hypothetical person of ordinary skill in the art can only apply what the prior art discloses and suggests. This hypothetical person cannot be creative or innovative. *See Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454, 227 USPQ 293, 298 (Fed. Cir. 1985) ("A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive, systematic research or by extraordinary insights, it makes no difference which").

Only with creativity can one of ordinary skill in the art derive the claimed removable-thermometer-from-a-knob-body out of the combination of Barbour and Bosch. The cited references only disclose two concepts:

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- (1) A removable thermometer, which is separate from the handle, in the cover of an outdoor cooking grill (Barbour); or
- (2) A thermometer integral with a handle of a fry pan, which cannot be separately removed from the handle<sup>1</sup> (Bosch).

As a result, the proposed combination of these two references would only form a lid with either a removable thermometer *separate* from the handle *or* a handle with an *integral* thermometer that cannot be removed. Any other combination (i.e., the claimed thermometer removable from a knob body) requires creativity.

When the changes from the prior art are of a simple or minor nature, it is even more important to rigorously apply the standards of obviousness so as to avoid hindsight analysis with the Applicants' specification. *See In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000); *In re Chu*, 66 F.3d 292, 298, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995). Here, where the changes from the prior art may only be simple, it is easy—as the Examiner's Answer has done—to use hindsight and impart creativity to one of ordinary skill in the art to suggest the claimed invention is obvious.

Merely identifying the claimed limitations individually is NOT sufficient to support an obviousness rejection. MPEP § 2143.01 ("The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.") Absent from the suggested motivations in the Examiner's Answer—because the prior art does not provide any—is any indication that one configuration or the other provides advantages or that one

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<sup>1</sup> Applicants also note that Bosch's knob and thermometer may be removed as a single unit. However, this removable single unit is not a disclosure of a thermometer removable from the knob. The thermometer in Bosch is integral with the handle and not removable therefrom for cleaning.

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configuration or the other has limitations. The prior art only teaches that Barbour and Bosch are equally acceptable configurations in cookware and that one is not preferred over the other. As a result, there is no motivation to derive a third configuration (i.e., the claimed configuration) from the combination of these references without using hindsight or creativity.

**B. Applicants are not arguing references individually**

The Examiner's Answer alleges that Applicants were arguing the references individually. (Examiner's Answer, p. 6). This argument is misplaced. As shown above in Section A and in the Appeal Brief at page 9, the combination of the cited references would only form a lid with either a removable thermometer separate from the handle or a handle with an integral thermometer that cannot be removed. To arrive at the claimed thermometer being removable from a knob body requires creativity and hindsight.

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## V. CONCLUSION

In view of the foregoing discussion, the Applicants respectfully request reversal of the rejection of the rejected, pending claims.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY



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